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Electron
Stamps
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	ROBERT M. VAVREK ET AL.)	
)	Group Art Unit:
)	2859
SERIAL NUMBER:	10/065,422 ✓)	
)	
FILED:	October 16, 2002 ✓)	Examiner:
)	Arana, Louis M.
)	
FOR:	GRADIENT COIL APPARATUS)	Confirmation No. 6750
	FOR MAGNETIC RESONANCE)	
	IMAGING)	

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AUG 12 2003

Commissioner for Patents
P.O. Box 1450
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RESPONSE TO RESTRICTION REQUIREMENT PURSUANT TO 35 U.S.C. §121

Sir:

This is in response to the Restriction Requirement dated August 07, 2003. The Examiner contends that: Group I, Claims 1 - 7 and 18 - 22, drawn to a coil assembly, classified in class 324, subclass 318; Group II, Claims 8 - 17 and 23 - 25, drawn to a method of operating a coil assembly, classified in class 324, subclass 322. Pursuant to MPEP §806 and 35 U.S.C. §121 the Examiner requires restriction between Groups I and II.

Accordingly, pursuant to 35 U.S.C. §121, Applicants hereby provisionally elect to prosecute Group I, Claims 1 - 7 and 18 - 22, with traverse. Favorable reconsideration and withdrawal of the Restriction Requirement is respectfully requested in view of the following remarks. The MPEP §803 require the Examiner to show that there would be some undue burden on the PTO to examine allegedly distinct inventions in a single

application. M.P.E.P. §803 sets forth the manner in which the Examiner must proceed as follows:

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

Applicants respectfully contend that the amount of searching, and thus, burden in the Patent Office, would not be reduced by the restriction requirement. Applicants recognize that restriction practice seeks to avoid multiple searches. However, if the search and examination of an entire application can be made without serious burden, the Examiner is encouraged to examine it on the merits even if it is considered to include claims to two or more different or independent inventions. The examiner has given no indication that there would be a serious burden of the type required and defined in the M.P.E.P.

Group I is an apparatus, while Group II includes a methodology. The MPEP specifically requires as between a process and apparatus for its practice, for distinctness the Examiner must show 1) the process as claim can be practice by another materially different apparatus or by hand, or (2) the apparatus as claim can be used to practice another and materially different process. The examiner cannot satisfy either condition in this instance. The apparatus cannot be utilized to practice a **materially** different process. Imaging where peripheral nerve stimulation is not a concern would not be considered materially different process as suggested by the Examiner. The method is still drawn to the broader class of magnetic resonance imaging. This is not a materially different process sufficient to justify restriction. Applicants acknowledge this as a distinction but contend that such a distinction approaches employing the invention in an unreasonable manner, e.g., not employing the most efficient imaging methodologies. Similarly, The

process cannot be practiced on a **materially** different apparatus than claimed in the system claims. Considering the method, (Claim 8) the method claimed is directed to a method of magnetic resonance imaging employing the unique features of the gradient coil apparatus from Claim 1. The Examiner has not shown how the process can be practiced on a **materially** different apparatus than claimed in the apparatus claims, nor how the apparatus can be utilized to practice a **materially** different process. Therefore, the Examiner has not made a prima facie case for restriction with the classifications provided and arguments therewith, therefore the restriction is improper and should be withdrawn. Moreover, once again, Applicants respectfully believe that there is no undue or serious burden and on this basis, the Applicants respectfully request the Examiner to withdraw the restriction requirement.

This election is being made without prejudice to Applicants' rights with respect to Group II, Claims 8 - 17 and 23 - 25, including the right to file divisional application(s) thereon.

If there are any charges with respect to this Restriction Requirement, or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

By: _____


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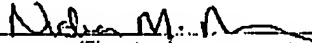
Date: August 12, 2002

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Invention: GRADIENT COIL APPARATUS FOR MAGNETIC RESONANCE IMAGING			
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